

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* IMRE HLAVICKSKA

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Appeal No. 97-2867  
Application 29/012,093<sup>1</sup>

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ON BRIEF

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Before COHEN, GARRIS, and CARMICHAEL, *Administrative Patent Judges*.

CARMICHAEL, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is an appeal from the final rejection of the claim in the present design patent application.

We reverse.

The Examiner's Answer lists the following prior art:

Matichen	4,298,074	Nov. 3, 1981.
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<sup>1</sup> Application for patent filed August 23, 1993. According to Appellant, this application is a continuation-in-part of Application No. 29/009,496 filed June 15, 1993, now abandoned.

## ***BACKGROUND***

### ***The claimed invention***

The claimed invention is a design for a burr shaft. As shown in Figures 1 and 6 for example, the design includes a long cylindrical shaft with an annulus a short distance from one end. The annulus is separated into contiguous detents. At various rotational orientations, the elevational view shows a cut-away annulus profile as in Figures 13-15 and 21 or a straight uninterrupted profile as in Figures 19 and 20.

### ***The Mattchen reference***

Mattchen discloses a chisel 10 as part of a tool for cutting through bone. As shown in Figure 1, chisel 10 narrows from shank 11 to cutting edge 13. Column 10, lines 18-20. As shown in Figures 3 and 5, shank 11 is polygonal. Between each two flat sides is an axially elongated edge. Each edge is interrupted by a detent 12 a short distance from one end.

### ***The examiner's rejection***

The design claim stands rejected under 35 U.S.C. § 103 as unpatentable over Mattchen.

It is the examiner's position that the claimed design is substantially disclosed by Mattchen except for a change in geometric shape of the shaft from polygonal to round. Examiner's

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Answer at 3. As to the proportion and arrangements of the detents, the examiner indicates that no patentable design significance can be attributed to a change in arrangement that is not consistently carried through all embodiments. Examiner's Answer at 6. The examiner also cites *In re Cornwall*, 239 F.2d 457, 109 USPQ 57 (CCPA 1956), for the proposition that patentability of a design cannot be based on an element which is concealed in normal use. Examiner's Answer at 5.

Appellant argues that the overall appearance of the claimed design is significantly altered from Mattchen and patentably distinct therefrom. Appeal Brief at 5. Appellant states that the contiguity and general shape of the detents are carried through all embodiments and are therefore entitled to consideration. Further, Appellant argues (Reply Brief at 1 and 2) that under *In re Webb*, 916 F.2d 1553, 16 USPQ2d 1433 (Fed. Cir. 1990), patentability may be based on the detents because the appearance is a matter of concern at many points in the life of the shaft. Appellant argues that the claimed design is essentially a cylindrical shaft with a scalloped band of recesses at one end. Appeal Brief at 3. Appellant contrasts this with Mattchen's polygonal shank having visually prominent axially

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extending edge lines and discontinuous detents. Appeal Brief at 5.

### ***DISCUSSION***

The starting point for an obviousness determination in a design patent application is whether there is something in existence, the design characteristics of which are basically the same as the claimed design. *In re Rosen*, 673 F.2d 388, 390, 213 USPQ 347, 349 (CCPA 1982).

In the present case, the design characteristics of the claimed design include the following. The most striking visual aspect of the claimed design is its appearance as a long cylinder. It gives a visual impression of extending in the axial direction a significant distance. Another design characteristic is the presence near one cylinder end of a circumferential array of recesses. The overall ornamental appearance of the design is largely one of an extended cylinder with the circumferential array of recesses being a short distance from one end.

We do not agree with the examiner's reasons for ignoring the visual impact of the circumferential array of recesses in the claimed design. As argued (Reply Brief at 1 and 2), the

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appearance is a matter of concern under *In re Webb* and is carried through all embodiments.

The design characteristics of Mattchen's shank portion 11 are as follows. The most striking ornamental aspect is the square appearance of the shank portion. As depicted in Figures 3 and 6, a circumferential array of detents 12 appears a short distance from one end of the shank.

The examiner has not convinced us that the design characteristics of the square shank of Mattchen are basically the same as the claimed design. In our opinion, the design characteristics of Mattchen's square shank simply do not evidence a something in existence, the design characteristics of which are

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basically the same as the claimed design portraying a dominant cylindrical appearance. Therefore, under *Rosen*, the rejection cannot be sustained.

***REVERSED***

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	APPEALS AND
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	)	INTERFERENCES
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	)	
JAMES T. CARMICHAEL	)	
Administrative Patent Judge	)	

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